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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,943	01/25/2001	Eyal Raz	UCAL173CON	8209

24353 7590 11/14/2005

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EXAMINER

DUFFY, PATRICIA ANN

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/770,943		RAZ ET AL.	
	Examiner		Art Unit	
	Patricia A. Duffy		1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-36 is/are rejected.
- 7) ☒ Claim(s) 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2005</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The finality of the rejection of the last Office action is withdrawn in view of the newly discovered art as set forth below.

The after final amendment filed 5-27-05 has been entered into the record. The terminal disclaimer is proper and has been entered into the record. Claims 32-37 are pending and under examination.

Information Disclosure Statement

The information disclosure statement filed 6-10-05 has been considered. An initialed copy is enclosed.

New Rejections

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32, 33, 35 and 36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bennett et al (WO 91/16901, published November 14, 1991).

The claims are drawn to a nucleic acid comprising a hexameric sequence of a particular structure in a pharmaceutically acceptable carrier, wherein the nucleic acid is 6 to 45 nucleotides in length or the hexameric structure is AAGGTT (see claim 36).

Bennett et al teach a nucleic acid of SEQ ID NO:12

(GGAAAGGTTTCCAGGGAAGAGG) wherein the nucleic acid or nucleic acid analog is in a

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pharmaceutically acceptable carrier (see pages 53-54, claims 18 and 19). Bennett et al teach analogs encompass phosphorothioate moieties or linking groups between nucleotide units are sulfur containing species (see page 54, claims 20 and 21). As such, Bennett et al anticipate the instantly claimed invention.

Claims 32, 33, 34 and 35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Draper et al (US Patent No. 5,514,577 issued May 7, 1996).

Draper et al teach a wide variety of pharmaceutical compositions comprising oligonucleotides, nucleic acid analogs and carriers/buffers/diluents, excipients (see column 7 line 25-column 8, line 7 and column 9, lines 1-43). In particular Draper et al teach SEQ ID NO:47, 48 and 51. SEQ ID NO:47 having the sequence of GTTGGAGACCGGIGTTGIG, SEQ ID NO:48 having the sequence GTTGGAGACCGGGITTGGGG, and SEQ ID NO:51 having the sequence GTTGGAGACCGGGGTTGGGI (see Table 4, columns 13-14). Each of the sequences set forth in SEQ ID NOS:47, 48 and 51 are less than 45 nucleotides in length. As such, Draper et al the pharmaceutical compositions comprising the recited sequences anticipate the instantly claimed invention.

Status of Claims

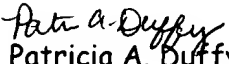
Claims 32-36 are rejected. Claim 37 is objected to as depending from a rejected base claim.


Conclusion

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A. Duffy whose telephone number is 571-272-0855. The examiner can generally be reached on M-Th 6:30 am - 6:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on 571-272-0864.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Patricia A. Duffy
Primary Examiner
Art Unit 1645


George C. Elliott, Ph.D
Director
Technology Center 1600